

ADMINISTRATIVE PANEL DECISION

Sanofi v. sven staes, president, fontana di luce corp
Case No. D2023-1583

1. The Parties

The Complainant is Sanofi, France, represented by Selarl Marchais & Associés, France.

The Respondent is sven staes, president, fontana di luce corp, United States of America.

2. The Domain Name and Registrar

The disputed domain name <sanofi.one> is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 12, 2023. On April 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 12, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (REDACTED FOR PRIVACY, Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 18, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on April 19, 2023.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 17, 2023.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on June 11, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

The registrant's identity was shielded by a privacy service located in Toronto, Canada, the Center sought and obtained the registrant details.

4. Factual Background

The Complainant is a pharmaceutical company based in France and is the registered proprietor of many trademarks consisting of the term SANOFI and SANOFI combined with device elements. Those registrations include the French trademark SANOFI number 96655339, registered on December 11, 1996, in classes 01; 03; 05; 09; 10; 35; 40; 42, notably concerning pharmaceutical products; French trademark SANOFI number 1482708, registered on August 11, 1988, in classes 01; 03; 04; 05; 10; 16; 25; 28; 31, notably concerning pharmaceutical products; European Union trademark SANOFI number 010167351, filed on August 2, 2011, and registered on January 7, 2012, in classes 03; 05, notably concerning pharmaceutical products; European Union trademark SANOFI number 004182325, filed on December 08, 2004, and registered on February 9, 2006, in classes 01; 09; 10; 16; 38; 41; 42; 44, notably concerning products in pharmaceutical and medical spheres; European Union trademark SANOFI number 000596023, filed on July 15, 1997, and registered on February 1, 1999, in classes 03; 05, notably concerning pharmaceutical products; International trademark SANOFI number 1092811, registered on August 11, 2011, in classes 01; 09; 10; 16; 38; 41; 42; 44, notably concerning products in pharmaceutical and medical spheres, and designating among others Australia, Georgia, Japan, Republic of Korea, Cuba, Russian Federation, Ukraine...; International trademark SANOFI number 1094854, registered on August 11, 2011 in classes 03; 05 notably concerning pharmaceutical products, and designating among others Australia, Georgia, Japan, Republic of Korea, Cuba, Russian Federation, Ukraine and Iceland ...; International trademark SANOFI number 674936, registered on June 11, 1997, in classes 03; 05, notably concerning pharmaceutical products and designating among others Switzerland, Cuba, Romania, Russian Federation, Ukraine...; and United States of America trademark SANOFI number 85396658, filed on August 12, 2011, and registered on July 24, 2012, in classes 05; 16; 41; 42; 44, notably concerning pharmaceutical products.

The Complainant also operates official websites, with the domain names <sanofi.com> registered on October 13, 1995; <sanofi.eu> registered on March 12, 2006; and <sanofi.fr> registered on October 10, 2006, amongst others.

The disputed domain name was registered on March 13, 2022, and does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant points out that all its trademark registrations for SANOFI predate the registration of the disputed domain name, and that it is impossible not to be aware of its SANOFI mark and attendant goodwill anywhere in the world. The Complainant says that its SANOFI trademark is highly distinctive, it has used its trade name for over 40 years and it has invested substantial financial resources over the years to advertise and promote the company and its SANOFI trademarks in countries all over the world. It contends that the reproduction of its trademarks as the unique and dominant part of the disputed domain name <sanofi.one> is confusingly similar to its prior trademarks, regardless of the generic Top-Level Domain ("gTLD") ".one". In this regard, the Complainant points out that it is well established that the gTLD used as part of a domain name should be disregarded as it does not serve to distinguish domain names. The relevant comparison to be made, according to the Complainant, is with the second level portion of a disputed domain name.

The Complainant also contends that it is well established that where a domain name incorporates a complainant's distinctive trademark in its entirety, it is confusingly similar to that mark as per numerous Panel decisions. Additionally, because its trademark SANOFI is well-known, as the Complainant maintains, the disputed domain name will be understood by Internet users as being a new website of the Complainant.

The Complainant contends that as the Respondent does not even appear in the Whois database, it is obvious that the latter has no rights or legitimate interests in the disputed domain name. Providing incomplete details of its identity indicates both an absence of any legitimate interest and bad faith. The word SANOFI has no inherent meaning and is not a generic term, and is highly distinctive, so the Respondent has neither prior rights or any legitimate interest that could justify its use, the Complainant maintains. The Complainant also confirms that it has never licensed or otherwise authorized the Respondent to use its trademarks or to register any domain name including them.

Further the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name nor using it in connection with a *bona fide* offering of goods or services, so as to confer a right or legitimate interest in it in accordance with paragraph 4(c)(i) of the Policy, given that the disputed domain name is not used legitimately in relation to a website by the Respondent.

The Complainant says that this is a case of opportunistic bad faith as it must be borne in mind that Panel decisions regularly recognize opportunistic bad faith in cases the disputed domain name appears confusingly similar to a complainant's well-known trademark.

Further, the Complainant says that an absence of good faith can be inferred from the absence of legitimate interests. The Complainant also asserts that given the famous and distinctive nature of the trademark SANOFI, the Respondent is likely to have had, at least constructive, if not actual notice, as to the existence of the Complainant's marks at the time the disputed domain name was registered. According to the Complainant this suggests that the Respondent acted with opportunistic bad faith in registering the disputed domain name in order to make an illegitimate use of it.

The Complainant further submits that the disputed domain name has obviously been registered for the purpose of creating a confusion – or at least an impression of association – between the SANOFI trademarks and domain names and the disputed domain name. It says that in circumstances where the well-known status of a complainant's trademarks is well-established, numerous UDRP decisions acknowledge that this consideration is, in itself, indicative of bad faith registration and use. Opportunistic bad faith is sufficient to justify a finding of bad faith use as well, the Complainant says. The disputed domain name leads to an inactive website, and since the panel in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), and many UDRP decisions have reiterated that passive holding under the appropriate circumstances falls within the concept of a domain name being used in bad faith.

Finally, the Complainant maintains that the Respondent is likely to cause irreparable prejudice to its goodwill because Internet users could be led to believe that the Complainant is not on the Internet or worse, that the Complainant is out of business. A case said to stand for this proposition according to the Complainant, is *M. Antonino Amaddeo (Reminiscence Diffusion Internationale) v. Gas Bijoux SAS / GAS Olivier*, WIPO Case No. [D2012-1831](#).

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

Since the gTLD extension “.one” is to be ignored in the comparison between the SANOFI registered trademark of the Complainant, and the disputed domain name, the latter is identical to the Complainant's trademark. The Complainant has thus met the requirements of the first element.

B. Rights or Legitimate Interests

The Respondent has not replied to the contentions of the Complainant and has thus put nothing before the Panel that could sustain a finding of rights or legitimate interests in his favor. The Complainant has not authorized the use of its SANOFI trademark by the Respondent in any manner, and there is nothing to indicate that it is known by that trademark or the disputed domain name. In fact, the Respondent's identity was shielded by a privacy service which further reinforces the conclusion that the Respondent has not acquired any legitimate rights or interests in relation to the highly distinctive SANOFI trademark of the Complainant. There is no conceivable legitimate reason for the Respondent to acquire a domain name that is identical to the Complainant's distinctive and widely known mark, and no actual or preparatory non-commercial or fair use has been made of it, as it does not in fact resolve to an active website.

Therefore, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The SANOFI trademark of the Complainant is distinctive, has been used by it as a proprietary mark in the pharmaceutical sector for many decades and long before registration of the disputed domain name, and has been heavily promoted and advertised by the Complainant. It is well established in many jurisdictions and readily recognized as a trademark of the Complainant, as well as its trading name. It is inconceivable, also because it is an invented and inherently meaningless term, that the Respondent chose to register an identical domain name unwittingly, by some fluke or coincidence. In any case, the shortest of Google searches would have revealed the Complainant's exclusive trademark rights in the term. The Respondent used a privacy service in Canada but has an address in the United States of America, where the SANOFI trademark is registered and widely known in relation to pharmaceuticals. It is almost impossible to imagine how the Respondent could ever make a legitimate and good faith use of the disputed domain name, and in any case, nothing has been done with the name nor preparations made for some putative but improbable good faith use.

Therefore, the Panel holds that the disputed domain name was registered and is being used in bad faith.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <sanofi.one> be transferred to the Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: June 23, 2023